

Appl. Ser. No. 09/762,985

Att. Docket No. 10191/1690

Reply to Final Office Action of August 21, 2003

REMARKS

Claim 72 is canceled, and therefore claims 42 to 73 are being considered, since claims 31 to 41 were previously withdrawn in response to a restriction requirement.

Claims 43, 44, 46, 48, 49 and 55 to 59 were amended to remove the reference numbers. No new matter was added and any revisions are supported in the specification.

Applicants respectfully request reconsideration of the present application in view of this response.

It is believed that this Amendment does not raise new issues that would require further consideration and/or search, and also does not raise the issue of new matter. It is also believed and respectfully submitted that this Amendment places the application in better form for appeal by materially reducing or simplifying the issues for appeal.

At page two (2) of the Final Office Action, claims 54 to 59 were rejected under the second paragraph of Section 112 as indefinite. Claim 54 has been rewritten to recite "a magnetic field" instead of "the magnetic field" at line 3 of the claim. It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

With respect to page three (3), claims 42 to 45, 47 to 53 and 61 to 71 were rejected under 35 U.S.C. § 103(a) as obvious over Kadomura, U.S. Patent No. 5,662,819 in view of the Collins et al., U.S. Patent No. 6,217,785.

As regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the "problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem", Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). The prior art simply does not address the problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Final Office Action's assertions that it would have been obvious to combine the references relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the

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Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Final Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

As regards the secondary “Collins” reference, the Final Office Action asserts that it would have been obvious to modify the system of the primary reference “so as to match the impedance of the ICP coil generator with the ICP source as suggested by Collins et al. because this will maximize the efficiency of power coupling to the ICP source”. Regardless of whether this assertion is even valid, this does not provide the necessary motivation for a person to modify the system of the “Kadomura” reference.

The claimed subject matter of the present application is used to provide the following benefits, as explained in the present application:

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In order too make the pulsing of the injected plasma power possible, it is further provided that during the pulsing, the impedance of the radio-frequency power generated via ICP coil generator 17 is continuously matched to the plasma impedance which changes as the plasma power is changed, i.e., pulsed. *For this purpose, the frequency of the radio-frequency electromagnetic alternating field generated by ICP coil generator 17 is varied for impedance matching within a specified bandwidth.*

In particular, the . . . symmetrically designed adaptor network in the second impedance transformer 18 which feeds ICP source 13 symmetrically is initially adjusted for this purpose in such a way that the best possible impedance matching is always present when the injected radio-frequency plasma power pulses have reached their maximum value. Typical maximum values are between 3 kilowatts and 20 kilowatts at a pulse to pause ratio of 1:1 to 1:10.

(Specification, page 11, line 33 to page 12, line 13).

Thus, although the obviousness rejections may not be agreed with, to facilitate matters, the feature of claim 72 has been included in claim 42, and claim 72 has been canceled. Accordingly claim 42 now provides that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”. It is noted that unpatentability rejections of claims 72 and 73 is not sustainable in any way, as explained below.

Accordingly, claim 42 as presented is allowable, as are claims 43 to 45, 47 to 53 and 61 to 71.

At page five (5), claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 were rejected as unpatentable under 35 U.S.C. § 103(a) over Savas, WO 97/14177 in view of the “Collins” reference.

As regards the secondary “Collins” reference, the Final Office Action asserts that it would have been obvious to modify the system of the primary reference “so as to match the impedance of the ICP coil generator with the ICP source as suggested by Collins et al. because this will maximize the efficiency of power coupling to the ICP source”. Regardless of whether this assertion is even valid, this does not provide the necessary motivation for a

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person to modify the system of the “Savas” reference., essentially for the same reasons explained above as to the “Kadomura” reference.

In any event, as explained above, claim 42 as presented is allowable, as are claims 43 to 45, 50 to 54, 56 to 59, 61 and 63 to 71, for essentially the same reasons explained above, since the feature of canceled claim 72 is now in claim 42, since claims 72 and 73 were never rejected, and since “Savas” does not cure the deficiencies of either the “Kadomura” or “Collins” references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page eight (8), claims 42 to 45, 50 to 53, 56 to 59, 61 and 63 to 71 were rejected as unpatentable under 35 U.S.C. § 103(a) over Koshimizu, U.S. Patent No. 5,935,373 in view of the “Collins” reference.

As regards the secondary “Collins” reference, the Final Office Action asserts that it would have been obvious to modify the system of the primary reference “so as to match the impedance of the ICP coil generator with the ICP source as suggested by Collins et al. because this will maximize the efficiency of power coupling to the ICP source”. Regardless of whether this assertion is even valid, this does not provide the necessary motivation for a person to modify the system of the “Koshimizu” reference., essentially for the same reasons explained above as to the “Kadomura” reference.

In any event, as explained above, claim 42 as presented is allowable, as are claims 43 to 45, 50 to 53, 56 to 59, 61 and 63 to 71, for essentially the same reasons explained above, since the feature of canceled claim 72 is now in claim 42, and since “Koshimizu” does not cure the critical deficiencies of either the “Kadomura” or “Collins” references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page eleven (11), claim 46 was rejected as unpatentable under 35 U.S.C. § 103(a) over “Kadomura” in view of the “Collins” reference as applied to claims 42 to 45, 47 to 53 and 61 to 71 and in further view of the “Koshimizu ‘687” reference, U.S. Patent No. 5,997,687.

As regards the secondary “Collins” reference and the third level “Koshimizu ‘687” reference, the Final Office Action relies on the assertion that it would have been obvious to modify the system of the primary reference “so as to match the impedance of the ICP coil

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generator with the ICP source as suggested by Collins et al. because this will maximize the efficiency of power coupling to the ICP source”, and that this system would then be further modified in view of the “Koshimizu ‘687” reference. Regardless of whether the assertions are even valid, this does not provide the necessary motivation for a person to modify the system of the “Kadomura” reference.

In any event, as explained above, claim 42 as presented is allowable, as is dependent claim 46, for essentially the same reasons explained above, since the feature of canceled claim 72 is now in claim 42, and since “Koshimizu ‘687” does not cure the critical deficiencies of either the “Kadomura” or “Collins” references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page eleven (11), claim 60 was rejected as unpatentable under 35 U.S.C. § 103(a) over “Kadomura” in view of the “Collins” reference as applied to claims 42 to 45, 47 to 53 and 61 to 71 and in further view of the “Laermer” reference.

As regards the secondary “Collins” reference and the third level “Laermer” reference, the Final Office Action relies on the assertion that it would have been obvious to modify the system of the primary reference “so as to match the impedance of the ICP coil generator with the ICP source as suggested by Collins et al. because this will maximize the efficiency of power coupling to the ICP source”, and that this system would then be further modified in view of the “Laermer” reference. Regardless of whether the assertions are even valid, this does not provide the necessary motivation for a person to modify the system of the “Kadomura” reference.

In any event, as explained above, claim 42 as presented is allowable, as is its dependent claim 60 for essentially the same reasons explained above, since the feature of canceled claim 72 is now in claim 42, and since “Laermer” does not cure the deficiencies of either the “Kadomura” or “Collins” references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page twelve (12), claim 46 was rejected as unpatentable under 35 U.S.C. § 103(a) over “Savas” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Koshimizu ‘687” reference.

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Claim 46 depends from claim 42, and is therefore allowable for the same reasons as claim 42 as presented over the “Savas” and “Collins” references, as explained above, since the third-level “Koshimizu” reference does not cure the critical deficiencies of the primary and secondary references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page thirteen (13), claim 60 was rejected as unpatentable under 35 U.S.C. § 103(a) over “Savas” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Laermer” reference.

Claim 60 depends from claim 42, and is therefore allowable for the same reasons as claim 42 as presented over the “Savas” and “Collins” references, as explained above, since the third-level “Laermer” reference does not cure the critical deficiencies of the primary and secondary references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page twelve (12), claims 47 to 49, 55 and 62 were rejected as unpatentable under 35 U.S.C. § 103(a) over “Savas” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Lymberopoulos” reference, U.S. Patent No. 6,085,688.

Claims 44 to 49, 55 and 62 depend from claim 42, and is therefore allowable for the same reasons as claim 42 as presented over the “Savas” and “Collins” references, as explained above, since the third-level “Lymberopoulos” reference does not cure the critical deficiencies of the primary and secondary references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page fifteen (15), claim 46 was rejected as unpatentable under 35 U.S.C. § 103(a) over “Koshimizu” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Koshimizu ‘687” reference.

Claim 46 depends from claim 42, and is therefore allowable for the same reasons as claim 42 as presented over the “Koshimizu” and “Collins” references, as explained above, since the third-level “Koshimizu ‘687” reference does not cure the critical deficiencies of the primary and secondary references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

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At page fifteen (15), claim 60 was rejected as unpatentable under 35 U.S.C. § 103(a) over “Koshimizu” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Laermer” reference.

Claim 60 depends from claim 42, and is therefore allowable for the same reasons as claim 42 as presented over the “Koshimizu” and “Collins” references, as explained above, since the third-level “Laermer” reference does not cure the critical deficiencies of the primary and secondary references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page sixteen (16), claims 47 to 49, 55 and 62 were rejected as unpatentable under 35 U.S.C. § 103(a) over “Koshimizu” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Lymberopoulos” reference, U.S. Patent No. 6,085,688.

Claims 44 to 49, 55 and 62 depend from claim 42, and is therefore allowable for the same reasons as claim 42 as presented over the “Koshimizu” and “Collins” references, as explained above, since the third-level “Lymberopoulos” reference does not cure the critical deficiencies of the primary and secondary references, nor does it provide the motivation to combine the references so as to provide the claimed subject matter of claim 42 and its resulting benefits.

At page seventeen (17), claims 72 and 73 were rejected as unpatentable under 35 U.S.C. § 103(a) over “Kadomura” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Wilbur” reference, U.S. Patent No. 6,020,794.

As regards the secondary “Collins” reference, the Final Office Action asserts that it would have been obvious to modify the system of the primary reference “so as to match the impedance of the ICP coil generator with the ICP source as suggested by Collins et al. because this will maximize the efficiency of power coupling to the ICP source”. Regardless of whether this assertion is even valid, this does not provide the necessary motivation for a person to modify the system of the “Kadomura” reference.

The claimed subject matter of the present application is used to provide the following benefits, as explained in the present application:

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In order too make the pulsing of the injected plasma power possible, it is further provided that during the pulsing, the impedance of the radio-frequency power generated via ICP coil generator 17 is continuously matched to the plasma impedance which changes as the plasma power is changed, i.e., pulsed. *For this purpose, the frequency of the radio-frequency electromagnetic alternating field generated by ICP coil generator 17 is varied for impedance matching within a specified bandwidth.*

In particular, the . . . symmetrically designed adaptor network in the second impedance transformer 18 which feeds ICP source 13 symmetrically is initially adjusted for this purpose in such a way that the best possible impedance matching is always present when the injected radio-frequency plasma power pulses have reached their maximum value. Typical maximum values are between 3 kilowatts and 20 kilowatts at a pulse to pause ratio of 1:1 to 1:10.

(Specification, page 11, line 33 to page 12, line 13).

Thus, although the obviousness rejections may not be agreed with, to facilitate matters, the feature of claim 72 has been included in claim 42, and claim 72 has been canceled. Accordingly claim 42 now provides that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”.

It is respectfully submitted that any review of the references relied upon makes plain that there is simply no motivation to combine the references in the manner asserted so as to provide that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”, and its benefits which are detailed in the Specification and referred to herein.

Accordingly claim 72 is allowable, although it has been canceled and its feature included in claim 42 to facilitate matters. Claim 73 includes a feature like that of claim 72, but it has been rewritten to reflect the fact that claim 42 now includes the feature of canceled claim 72. Accordingly, claim 73 is allowable at least because it depends from allowable claim 42.

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At page eighteen (18), claims 72 and 73 were rejected as unpatentable under 35 U.S.C. § 103(a) over “Savas” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Wilbur” reference, U.S. Patent No. 6,020,794.

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As explained above, although the obviousness rejections may not be agreed with, to facilitate matters, the feature of claim 72 has been included in claim 42, and claim 72 has been canceled. Accordingly claim 42 now provides that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”.

It is respectfully submitted that any review of the references relied upon makes plain that there is simply no motivation to combine the references in the manner asserted so as to provide that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”, and its benefits which are detailed in the Specification and referred to herein.

Accordingly claim 72 is allowable, although it has been canceled and its feature included in claim 42 to facilitate matters. Claim 73 includes a feature like that of claim 72, but it has been rewritten to reflect the fact that claim 42 now includes the feature of canceled claim 72. Accordingly, claim 73 is allowable at least because it depends from allowable claim 42.

At page nineteen (19), claims 72 and 73 were rejected as unpatentable under 35 U.S.C. § 103(a) over “Koshimizu” in view of the “Collins” reference as applied to claims 42 to 45, 50 to 54, 56 to 59, 61 and 63 to 71 and in further view of the “Wilbur” reference, U.S. Patent No. 6,020,794.

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As explained above, although the obviousness rejections may not be agreed with, to facilitate matters, the feature of claim 72 has been included in claim 42, and claim 72 has been canceled. Accordingly claim 42 now provides that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”.

It is respectfully submitted that any review of the references relied upon makes plain that there is simply no motivation to combine the references in the manner asserted so as to provide that the “ICP coil generator causes a variation of the frequency of the radio-frequency electromagnetic alternating field so that the impedance is matched as a function of the pulsed plasma power to be injected”, and its benefits which are detailed in the Specification and referred to herein.

Accordingly claim 72 is allowable, although it has been canceled and its feature included in claim 42 to facilitate matters. Claim 73 includes a feature like that of claim 72, but it has been rewritten to reflect the fact that claim 42 now includes the feature of canceled claim 72. Accordingly, claim 73 is allowable at least because it depends from allowable claim 42.

As further regards the obviousness rejections, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in*

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mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

More recent still, in the case of In re Lee, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....
In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a

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relevant factor required by precedent is both legal error and arbitrary agency action.

[The] “common knowledge and common sense” on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency’s obligation.

[The] Board’s findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency’s expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

In short, there is no evidence that the references relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard -- the evidence for which does not include “broad conclusory statements standing alone”. (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of

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the problem to be solved"))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and any Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Patent Office bears the initial burden of presenting a proper prima facie unpatentability case -- which has not been met in the present case. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, claims 42 to 71 and 73 are allowable for all of the above reasons.

CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 42 to 71 and 73 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,
KENYON & KENYON

By:

Richard L. Mayer
(Reg. No. 22,490)

One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646

631122